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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,341	11/29/2001	Harold R. Garner	119929-1040	5540
7590 11/19/2003			EXAMINER	
Chalker Flores, LLP			FORMAN, BETTY J	
12700 Park Central			ART UNIT	
Suite 455			PAPER NUMBER	
Dallas, TX 75251			1634	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/998,341	Applicant(s) GARNER, HAROLD R.	
	Examiner BJ Forman	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>1103</u> ⁺ <u>1103</u> ^B |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

FINAL ACTION

Status of the Claims

1. This action is in response to papers filed 2 September 2003 in which claims 42, 48, 51 were amended; claims 57-58 were added; and a Declaration filed under 37 C.F.R. 1.131 was submitted. All of the amendments have been thoroughly reviewed and entered.

The previous objections rejections in the Office Action dated 26 June 2003 under 35 U.S.C. 112 are withdrawn in view of the amendments.

The previous rejections under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) as reiterated below are maintained. Rejections not reiterated are withdrawn in view of the amendments and/or Declaration. All of the arguments have been thoroughly reviewed and are discussed below. New grounds for rejection necessitated by the amendments are discussed.

Claims 39-58 are under prosecution.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1634

3. Claims 39-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Cerrina et al (U.S. Patent No. 6,375,903, filed 23 February 1998).

Regarding Claim 39, Cerrina et al disclose an apparatus comprising a light source, a computer-controlled micromirror positioned to redirect light from the light source toward the substrate, and a reaction chamber (Column 4, lines 45-65 and Claims 1-31).

Regarding Claim 40, Cerrina et al disclose the apparatus wherein the light source comprises a UV light (Column 4, lines 66-67 and Claims 1-31).

Regarding Claim 41, Cerrina et al disclose the apparatus further comprising a lens (Column 5, lines 1-29 and Claims 1-31).

Regarding Claim 42, Cerrina et al disclose the apparatus wherein the lens comprises a lens system which changes magnification of light reflected by the micromirror (Column 5, lines 25-40 and Claims 1-31).

Regarding Claim 43, Cerrina et al disclose the apparatus wherein the micromirror is a micromirror array (Column 5, lines 41-43 and Claims 1-31).

Regarding Claim 44, Cerrina et al disclose the apparatus wherein the light catalyzes synthesis (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function see *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP, 2114).

Regarding Claim 45, Cerrina et al disclose the apparatus wherein the light catalyzes synthesis (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation

Art Unit: 1634

“catalyzes synthesis” is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 46, Cerrina et al disclose the apparatus wherein the light catalyzes a reaction (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation “catalyzes a reaction” is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 47, Cerrina et al disclose the apparatus wherein the light crosslinks a molecule (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation “crosslinks a molecule” is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 48, Cerrina et al disclose an apparatus comprising a light source, a micromirror positioned to redirect light from the light source toward a substrate, a reaction chamber disposed on the substrate, one or more reactant lines connected to the chamber Fig. 1, # 20 and #21), one or more reaction chemicals connected to the reactant lines and a computer connected to and controlling the micromirror and the supply of reactants (Column 4, line 45-Column 5, line 40 and Claims 1-31).

Regarding Claim 49, Cerrina et al disclose the apparatus wherein the light source comprises a UV light (Column 4, lines 66-67 and Claims 1-31).

Regarding Claim 50, Cerrina et al disclose the apparatus further comprising a lens (Column 5, lines 1-29 and Claims 1-31).

Regarding Claim 51, Cerrina et al disclose the apparatus wherein the lens comprises a lens system which changes magnification of light reflected by the micromirror (Column 5, lines 25-40 and Claims 1-31).

Regarding Claim 52, Cerrina et al disclose the apparatus wherein the micromirror is a micromirror array (Column 5, lines 41-43 and Claims 1-31).

Art Unit: 1634

Regarding Claim 53, Cerrina et al disclose the apparatus wherein the light catalyzes synthesis (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 54, Cerrina et al disclose the apparatus wherein the light catalyzes synthesis (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 55, Cerrina et al disclose the apparatus wherein the light catalyzes a reaction (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation "catalyzes a reaction" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 56, Cerrina et al disclose the apparatus wherein the light crosslinks a molecule (Column 6, lines 44-67 and Claims 1-31). However, it is noted that the recitation "crosslinks a molecule" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 57, Cerrina disclose the apparatus of Claim 39 wherein the light source is a mercury lamp (Column 4, line 67).

Regarding Claim 58, Cerrina disclose the apparatus of Claim 48 wherein the light source is a mercury lamp (Column 4, line 67).

Response to Remarks and Declaration

4. The Declaration under 37 CFR 1.131 filed 2 September is insufficient to overcome the rejection of claims 39-58 based upon Cerrina as set forth in the last Office action because: The Cerrina reference is patented. The instant claims and the patent claims are both drawn to an apparatus comprising a light source, a micromirror array, and a reaction chamber. Therefore, the instantly claimed apparatus and the patent apparatus are not patentably distinct. A

Art Unit: 1634

showing under 37 C.F.R. 1.608(b) must be provided to provoke an interference with the cited reference (see MPEM 2308.01).

If the effective filing date of the application is more than 3 months after the effective filing date of the patent, 37 CFR 1.608(b) requires that the applicant must file (A) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee, and (B) an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment.

If an applicant is claiming the same invention as a patent which has an earlier effective United States filing date but there is not a statutory bar against the application, and the applicant has not submitted the items required by 37 CFR 1.608(a) or (b), as appropriate, the application should be rejected under 35 U.S.C. 102(e)/103. A statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings. Note, however, 35 U.S.C. 135(b) and MPEP § 2307. The applicant should also be advised that an affidavit under 37 CFR 1.608(b) or evidence and an explanation under 37 CFR 1.608(b), as appropriate, must be submitted and it should be stated, if applicable, that the patentee has been accorded the benefit of an earlier U.S. application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1634

6. Claims 39-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al (U.S. Patent No. 5,959,098 filed 17 April 1996) in view of Sweatt et al (U.S. Patent No. 5,870,176, filed 18 June 1997).

Regarding Claim 39, Goldberg et al teach an apparatus comprising a light source, a computer-controlled mirrors positioned to redirect light from the light source toward the substrate, and a reaction chamber (Column 15, lines 13-65; Column 16, line 55-67; and Fig. 3A, 4A and 4C). Goldberg et al teach the apparatus comprises mirrors (Column 15, lines 15-19) but they do not specifically teach the mirrors are micromirrors. Sweatt et al teach the similar apparatus wherein the mirrors are micromirrors which replace the need for masks traditionally used in lithography (Column 2, lines 39-65). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the micromirrors of Sweatt et al to the mirrored light direction of Goldberg et al thereby eliminating the need for masks the problems resulting from masks i.e. alignment and mask defects as taught by Sweatt et al (Column 2, lines 1-12).

Regarding Claim 40, Goldberg et al teach the apparatus wherein the light source comprises a UV light (Column 17, lines 14-15) and Sweatt et al teach the apparatus wherein the light source is UV light (Column 6, lines 25-40).

Regarding Claim 41, Goldberg et al teach the apparatus further comprising a lens (Column 15, lines 15-19).

Regarding Claim 42, Goldberg et al teach the apparatus wherein the lens comprises a lens system which changes magnification of light reflected by the micromirror (Column 26, lines 58/-65).

Regarding Claim 43, Goldberg et al teach the apparatus comprises mirrors (Column 15, lines 15-19) but the do not specifically the mirror is a micromirror array. However, Sweatt et al teach the similar apparatus wherein the micromirror is a micromirror array (Column 2, lines 38-65).

Art Unit: 1634

Regarding Claim 44, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 45, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 46, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "catalyzes a reaction" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 47, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "crosslinks a molecule" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 48, Goldberg et al disclose an apparatus comprising a light source, a mirror positioned to redirect light from the light source toward a substrate, a reaction chamber disposed on the substrate, one or more reactant lines connected to the chamber (Fig. 4A, #307 and #306 and Column 15, lines 56-65), one or more reaction chemicals connected to the reactant lines and a computer connected to and controlling the mirror and the supply of reactants (Column 15, lines 13-65; Column 16, line 55-67; and Fig. 3A, 4A and 4C). Goldberg et al teach the apparatus comprises mirrors (Column 15, lines 15-19) but they do not specifically teach the mirrors are micromirrors. Sweatt et al teach the similar apparatus wherein the mirrors are micromirrors which replace the need for masks traditionally used in lithography (Column 2, lines 39-65). It would have been obvious to one of ordinary skill in the

Art Unit: 1634

art at the time the claimed invention was made to apply the micromirrors of Sweatt et al to the mirrored light direction of Goldberg et al thereby eliminating the need for masks the problems resulting from masks i.e. alignment and mask defects as taught by Sweatt et al (Column 2, lines 1-12).

Regarding Claim 49, Goldberg et al teach the apparatus wherein the light source comprises a UV light (Column 17, lines 14-15) and Sweatt et al teach the apparatus wherein the light source is UV light (Column 6, lines 25-40).

Regarding Claim 50, Goldberg et al teach the apparatus further comprising a lens (Column 15, lines 15-19).

Regarding Claim 51, Goldberg et al teach the apparatus wherein the lens comprises a lens system which changes magnification of light reflected by the micromirror (Column 26, lines 58/-65).

Regarding Claim 52, Goldberg et al teach the apparatus comprises mirrors (Column 15, lines 15-19) but the do not specifically the mirror is a micromirror array. However, Sweatt et al teach the similar apparatus wherein the micromirror is a micromirror array (Column 2, lines 38-65).

Regarding Claim 53, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 54, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "catalyzes synthesis" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 55, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic

Art Unit: 1634

(Column 4, lines 45-57). However, it is noted that the recitation "catalyzes a reaction" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 56, Goldberg et al teach the apparatus wherein the light is catalytic (Column 17, lines 25-43) and Sweatt et al teach the apparatus wherein the light is catalytic (Column 4, lines 45-57). However, it is noted that the recitation "crosslinks a molecule" is functional language which does not describe or define structural properties of the apparatus.

Regarding Claim 57, Goldberg et al disclose the apparatus of Claim 39 wherein the light source is a mercury lamp (Column 18, lines 5-15).

Regarding Claim 58, Goldberg et al disclose the apparatus of Claim 48 wherein the light source is a mercury lamp (Column 18, lines 5-15).

Response to Arguments

7. Applicant argues that Goldberg et al do not teach or suggest maskless digital optical chemistry and therefore do not teach or suggest the instant invention. The argument has been considered but is not found persuasive because the instant claims are drawn to an apparatus comprising a light source, a computer-controlled micromirror and a reaction chamber. The open claim language "comprising" encompasses any additional components (e.g. mask) disclosed by Goldberg.

Applicant argues that the cited references do not teach or suggest their combination. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sweatt et al provide a motivation for modification of masked photolithography i.e. masks have alignment and defect problems (column 2, lines 1-12).

Art Unit: 1634

Therefore, one of ordinary skill would have been motivated by the teaching of Sweatt modify the photolithograph of Goldberg et al by utilizing micromirrors of Sweatt to thereby eliminate the need for masks and further eliminate alignment and defect problems resulting from masks (Sweatt, Column 2, lines 1-12).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 39-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,295,153.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to an apparatus for catalyzing a reaction on a substrate comprising a light source, a computer-controlled micromirror and a reaction chamber. The claims differ only in the patent claims are further drawn to a diffusion lens. However, the open claim language "comprising" recited in the instant claims encompasses any additional components in the patent claims. Furthermore, because the instant claims encompass the patented apparatus, the instantly claimed apparatus is a genus of the patent species.

Art Unit: 1634

The courts have stated that a genus is obvious in view of the teaching of a species see Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); and In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). Therefore the instantly claimed apparatus (i.e. genus) is obvious in view of the '153 (i.e. species) apparatus.

Response to Comments

10. Applicant's intention to file a Terminal Disclaimer upon notification of allowable subject matter is acknowledged.

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1634

Conclusion

13. No claim is allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.
Primary Examiner
Art Unit: 1634
November 17, 2003